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09/540,756	03/31/2000	Laura L. Mahan	81395-157	3424

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/540,756

Applicant(s)

MAHAN ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14-26 and 33-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-26 and 33-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the application amendment, filed on 4/4/2005.
2. Applicant has amended claims 1-8 and 14-25, and added new claims 37-41.
3. Claims 1-8, 14-26 and 33-41 are pending in the case, claims 1, 14, 15, 16, 17 and 41 are independent claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."
5. Claims 1, 14, 15, 16, 17 and 38-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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6. **Regarding claim 1**, the amendment filed 4/4/2005 adds the following limitations: *"receiving user selection input while at least some of said plurality of multimedia"* (second limitation, new matter shown underlined), and *"copying said page including said plurality of multimedia"* (third limitation, new matter shown underlined). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
7. **Regarding claim 14**, the amendment filed 4/4/2005 adds the following limitations: *"receive user selection input while at least some of said plurality of multimedia"* (first limitation, new matter shown underlined), and *"copy said page including said plurality of multimedia"* (second limitation, new matter shown underlined). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
8. **Regarding claim 15**, the amendment filed 4/4/2005 adds the following limitations: *"receive user selection input while at least some of said plurality of multimedia"* (first limitation, new matter shown underlined), and *"copy said page including said plurality of multimedia"* (second limitation, new matter shown underlined). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

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9. **Regarding claim 17**, the amendment filed 4/4/2005 adds the following limitations: "*receive user selection input while at least some of said plurality of multimedia*" (second limitation, new matter shown underlined), and "*copying said page including said plurality of multimedia*" (third limitation, new matter shown underlined). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
10. **Regarding claim 39**, the amendment filed 4/4/2005 adds the following limitations: "*the method comprising repeating the method of claim 1 in respect of each*" (new matter shown underlined). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
11. **Regarding claim 40**, the amendment filed 4/4/2005 adds the following limitations: "*comprising storing, in a presentation file, an indication of an order in which said plurality of pages in said memory are to be accessed by said presentation*" (new matter shown underlined). In the amendment filed 4/4/2005, on page 13, in the second paragraph, the applicant has indicated that support for this limitation could be found in the originally filed specification on page 2, lines 15-22; page 5, lines 17-23; and page 8 lines 14-15. The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. The background section on page 2, lines

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15-22 describe that an object of the invention is "*content ... is presented in an order specified by the user*", however the other cited passages fail to enable this limitation. Applicant is required to cancel the new matter in response to this office action.

12. **Regarding claim 41**, the amendment filed 4/4/2005 adds the following limitations: "*user selection input received while at least some of said of multimedia*" (second limitation, new matter shown underlined), "*copying said page including said multimedia*" (third limitation, new matter shown underlined), "*in the presentation in a specific order relative to other pages and their respective*" (fifth limitation, new matter shown underlined), and "*for accessing, in said specific order, respective multimedia content*" (second limitation, new matter shown underlined). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 902 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

14. Claims 1-3, 6-8, 14-19, 22-26, 33 and 35 remain rejected and new claims 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gill et al. US Patent 6,081,262, filed 12/4/1996, patented 6/27/2000 (hereinafter "*Gill*") in view of Protheroe et al. US Patent 6,414,686, filed 3/31/1999, patented 7/2/2002 (hereinafter "*Protheroe*").

15. **Regarding independent claim 1**, Gill discloses a presentation building method. Gill recites: "*This invention pertains to a multi-media presentation generation system that uses a multi-media authoring tool*" (column 1, lines 6-7). Gill discloses a multimedia content application. Gill recites: "*The multi-media presentation generation system comprises a menu driven multi-media presentation generation system MPG, executing on a processor P, which accesses data from any of a multitude of media sources S1-S6*" (column 5, lines 10-15). Gill discloses accessing a page that includes a plurality of multimedia content. Gill recites: "*At step 402, the multi-media authoring tool A*

begins gathering information which characterizes the multi-media presentation by querying the page based document layout system Q to locate presentation based multi-media information which is needed to create an export object" (column 15, lines 44-49).

Gill discloses a multimedia content application that accesses multimedia content. Gill recites: *"The multi-media presentation generation system MPG also comprises a software extension feature QC which functions to interconnect the page based document layout system Q with at least one source of media objects S1-S6"* (column 5, lines 41-44), where Gill defines media objects as: *"external sources including, but not limited to, data communication connections to broadcast media, such as Internet S4"* (column 6, lines 3-5).

Gill discloses a presentation window for previews of at least some of the multimedia content in Figure 2 at reference sign MB. Gill discloses multimedia selected by the user. Gill recites: *"The author must populate each of the individual frames with the selected video, graphical, and textual material"* (column 1, lines 34-36). Gill discloses a preview for the multimedia page in Figure 1 at reference sign Q (shown as *"Page Based Layout System"*).

Gill discloses copying multimedia content into memory. Gill recites: *"the author defines a movie object MB into which is imported a movie, which is stored in memory, and obtained from one of the sources named above"* (column 10, lines 11-13). Gill discloses copying the multimedia page into

memory in Figure 4 at reference sign 403 (shown as *"Gather Page Level Multi-Media Data"*).

Gill discloses a multimedia authoring system as described above. Gill fails to disclose selecting multimedia content while it is playing. Protheroe teaches the playback of a multimedia object for selection purposes. Protheroe recites: *"A means within the display is also provided for viewing or listening to the content of an individual clip and then selecting a portion to be used in the final presentation"* (column 1, lines 64-67).

Therefore, it would have been obvious, for one of ordinary skill in the art, at the time the invention was made, to provide previewing of multimedia content as taught by Protheroe with the multimedia content authoring system of Gill in order to provide: *"computer based systems for composing and editing video and audio sequences comprising a plurality of components"* (Protheroe, column 1, lines 7-9).

16. **Regarding dependent claim 2**, Gill discloses copying the plurality of multimedia content in a transparent manner. Gill recites: *"Since the multi-media data is stored and processed by the page based document layout system Q in a transparent manner"* (column 15, lines 49-51).
17. **Regarding dependent claim 3**, Gill discloses the use of an identifier for plurality of the multimedia content. Gill recites: *"The multi-media authoring tool assigns a unique identification to each object that has multi-media*

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information and that is located in the multi-media presentation" (column 4, lines 12-14).

18. **Regarding dependent claim 6**, Gill discloses associating textual notes with the plurality of multimedia content. Gill recites: "*The author must populate each of the individual frames with the selected video, graphical, and textual material*" (column 1, lines 34-36).
19. **Regarding dependent claim 7**, Gill discloses the use of links. Gill recites: "*for multi-media content, with the hidden information which defines the multi-media content*" (column 7, lines 28-30) and "*The author also defines a path PL ... The path PL represents a motion definition for a object having some content, which object is tied to the path*" (column 10, lines 21-26).
20. **Regarding dependent claim 8**, the claim contains substantially the same subject matter as claim 3, and is rejected using the same rationale.
21. **Regarding independent claim 14**, the claim is directed toward a computer-readable medium for the method of claim 1, and is rejected using the same rationale.
22. **Regarding independent claim 15**, the claim is directed toward a signal readable by a computer for the method of claim 1, and is rejected using the same rationale.

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23. **Regarding independent claim 16**, the claim is directed toward an apparatus for the method of claim 1, and is rejected using the same rationale.
24. **Regarding independent claim 17**, the claim is directed toward an apparatus for the method of claim 1, and is rejected using the same rationale.
25. **Regarding dependent claim 18**, the claim is directed toward an apparatus for the method of claim 2 and is rejected using the same rationale.
26. **Regarding dependent claim 19**, the claim is directed toward an apparatus for the method of claim 3 and is rejected using the same rationale.
27. **Regarding dependent claim 22**, the claim is directed toward an apparatus for the method of claim 6 and is rejected using the same rationale.
28. **Regarding dependent claim 23**, the claim is directed toward an apparatus for the method of claim 7 and is rejected using the same rationale.
29. **Regarding dependent claim 24**, the claim is directed toward an apparatus for the method of claim 8 and is rejected using the same rationale.
30. **Regarding dependent claim 25**, the claim is directed toward an apparatus for the method of claim 1 and is rejected using the same rationale.
31. **Regarding dependent claim 26**, the claim is directed toward an apparatus for the method of claim 1 and is rejected using the same rationale.

32. **Regarding dependent claim 33**, Gill discloses a concurrent presentation window for previews in Figure 2 at reference sign MB. Gill discloses displaying the multimedia content. Gill recites: *"The underlying page based document layout system is a menu based system which functions to partition document pages, as defined by the author, into a plurality of objects (also termed boxes), each of which is independently editable by the author"* (column 6, lines 23-27).
33. **Regarding dependent claim 35**, the claim is directed toward an apparatus for the method of claim 33 and is rejected with the same rationale.
34. **Regarding dependent claim 38**, Gill discloses copying multimedia content of more than one type. Gill recites: *"Since the multi-media data is stored and processed by the page based document layout system Q in a transparent manner, the data is identified by tags which note the multi-media nature of the particular data object"* (column 15, lines 49-53).
35. **Regarding dependent claim 39**, Gill discloses repeating the method of claim 1 for a plurality of pages. Gill recites: *"This page based document layout system partitions document pages, as defined by the author, into a plurality of objects"* (column 3, lines 37-39).
36. **Regarding dependent claim 40**, Gill discloses the use of an indication for the order of the multimedia content and the pages are accessed. Gill recites: *"each item is either in front of or behind other items. The "stacking order" is a*

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term which refers to the front/back relationships among the various items of a page layout" (column 7, lines 49-52). Gill further discloses the ordering of pages in Figure 1, where page numbering indicates the order of the pages (shown as "*Page number*" near the bottom of the figure).

37. **Regarding independent claim 41**, the claim contains substantially the same subject matter as claims 1, 3 and 40 combined, and is rejected with the same rationale.

38. Claim 4, 5, 20, 21, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gill in view of Protheroe, and in further view of Fields et al. US Patent 6,128,655, filed 7/10/1998, patented 10/3/2000 (hereinafter "*Fields*").

39. **Regarding dependent claim 4**, the claim is directed toward using a uniform resource locator (URL) as an identifier. Gill and Protheroe discloses the use of an identifier for the multimedia content as described above. Gill and Protheroe fail to disclose the use of URLs as identifiers. Fields teaches that a URL can be used as an identifier. Fields recites: "*In the Internet paradigm, a network path to a server is identified by a so-called Uniform Resource Locator (URL)*" (column 1, lines 17-19).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to use URLs as identifiers to Internet as taught by Fields with the multimedia content authoring system of Gill and Protheroe in order to provide the "*reuse content form a variety of different*

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content providers some of which may use radically different formats and other content" (Fields, column 2, lines 44-46).

40. **Regarding dependent claim 5**, the claim is directed toward using a uniform resource locator (URL) as an identifier while said multimedia content is in use by an application. The limitations of this claim contain substantially the same subject matter as claims 1 and 4 combined, and are rejected with the same rationale.
41. **Regarding dependent claim 20**, the claim is directed toward an apparatus for the method of claim 4, and is rejected using the same rationale.
42. **Regarding dependent claim 21**, the claim is directed toward an apparatus for the method of claim 5, and is rejected using the same rationale.
43. **Regarding dependent claim 34**, Gill and Protheroe disclose the use of an identifier as described above. Gill and Protheroe fail to disclose displaying the identifier. Fields teaches displaying identifier information. Fields discloses in Figure 3A, the media identifier (shown as "<http://www.ibm.com/Services/pressrel/pr.890622721.html>") displayed with the media information (shown at reference sign 203).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the multimedia authoring system of Gill and Protheroe with the displayed identifiers as taught by Fields in order

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to allow presentation viewers the capability to view media material source identifiers.

44. **Regarding dependent claim 36**, the claim is directed toward an apparatus for the method of claim 34, and is rejected using the same rationale.

Response to Arguments

45. Applicant's arguments filed 4/4/2005 have been fully considered but they are not persuasive.
46. **Regarding claim 1**, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *"user-friendly"*, *"presented at a later date by a presentation application"*, *"building a presentation is simple and requires minimal expertise and effort"* and *"unnecessary for the user to manually define individual multimedia content items"* page 13, third paragraph of the amendment filed 4/4/2005) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claim. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
47. **Also regarding claim 1**, in response to applicant's argument that *"Gill et al. fails to disclose 'copying said page including said plurality of multimedia content [...] from said multimedia source to memory for access by a presentation application'"* (page 14, third paragraph of the amendment filed 4/4/2005), applicant is directed to the 35 USC 112 rejection of the claim, as stated above, as well as the 35 USC 103 rejection of the claim, also stated above.

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48. **Also regarding claim 1**, in response to applicant's argument that "*Gill et al. fails to disclose 'copying said page including said plurality of multimedia content [...] from said multimedia source to memory for access by a presentation application'*" (page 15, third paragraph of the amendment filed 4/4/2005), applicant is directed to the 35 USC 112 rejection of the claim, as stated above, as well as the 35 USC 103 rejection of the claim, also stated above.

49. **Also regarding claim 1**, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*Gill et al. do not appear to disclose a page being presented in a movie box*" page 15, fourth paragraph of the amendment filed 4/4/2005) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claim. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

50. **Also regarding claim 1**, in response to applicant's argument that "*Nor do Gill et al. disclose the page including a plurality of multimedia content*" and "*Gill et al. do not appear to disclose a preview window in which the page is presented*" (page 15, fourth paragraph of the amendment filed 4/4/2005), applicant is directed to the rejection of the claim, as stated above.

51. **Also regarding claim 1**, in response to applicant's argument that Protheroe fails to teach selecting multimedia content while it is playing (page

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16, first paragraph of the amendment filed 4/4/2005), the applicant is directed to the rejection of the claim, as stated above. The teaching within Protheroe used by the examiner is: "*A means within the display is also provided for viewing or listening to the content of an individual clip and then selecting a portion to be used in the final presentation*" (column 1, lines 64-67). It appears the applicant has determined that the action "*and then selecting*" is being performed after the multimedia has stopped playing. The examiner respectfully disagrees, and considers the "*and then selecting*" action is after the "*viewing or listening*" action but prior to the end of the playback of the multimedia.

Conclusion

52. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
June 8, 2005


STEPHEN HONG
PATENT EXAMINER